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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/814,109	06/29/2001	Michael Borges		2069

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EXAMINER

HORTON, YVONNE MICHELE

ART UNIT PAPER NUMBER

3635

DATE MAILED: 10/10/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/814,109

Applicant(s)

MICHAEL BORGES

Examiner

YVONNE M. HORTON

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jul 29, 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7, 9, and 10 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7, 9, and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1,5 and 7 stand rejected under 35 U.S.C. 102(b) as being anticipated by US Patent #5,502,935 to DEMMER. DEMMER discloses a skylight conduit (10) including a roof mounted skylight (12) having a dome (22) in a roof aperture (14) for receiving light (15) from a roof (11); a ceiling mounted fixture (16) for mounting in a ceiling aperture (18) for conveying light (15) to the inside of a room (13); and a flexible light and air conducting tube (20) connected to the skylight (12) and ceiling mounted fixture (16) wherein the tube (20) has an inner reflective wall (54), column 7, lines 65-67, a outer fire retardant wall (56), and a insulating core (58). In regards to claim 5, the conduit (20) is round with pleats. However, the conduit (20) is capable of being polygonal in cross-section, column 8, lines 18-19. Inherently, a square is included as a polygon.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 2 and 3 stand rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #5,502,935 to DEMMER in view of US Patent #5,435,780 to AYLES. As detailed in paragraph 2 above, DEMMER discloses the basic claimed skylight conduit except for the reflective inner wall specifically being metallized plastic. AYLES teaches that it is known in the art to form the inner wall of a tube (14) out of metallized plastic, column 3, lines 42-48. Hence,

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it would have been obvious to one having ordinary skill in the art to form the inner wall of DEMMER out of the metallized plastic of AYLES in order to effectively allow the passage of sunlight from the roof, down the tubular member, and into the room. In regards to claim 3, insulated center core (58) of DEMMER is an injectable foam which inherently is formed having tiny air bubbles.

5. Claim 4 stands rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #5,502,935 to DEMMER in view of US Patent #5,435,780 to AYLES as applied to claim 1 above, and further in view of US Patent #4,339,900 to FREEMAN. DEMMER, as modified by AYLES, discloses the basic claimed skylight except for the outer wall specifically being metal foil. FREEMAN teaches that it is known in the art to form the outer wall of a tubular skylight conduit (17) out of metal foil, column 1, line 46. Hence, it would have been obvious to one having ordinary skill in the art to form the outer wall of DEMMER, as modified by AYLES with the outer wall of FREEMAN in order to maintain a highly reflective skylight conduit that is light weight and cost effective while also having a conduit that is capable of resisting fire damage.

6. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #5,502,935 to DEMMER in view of US Patent #6,219,977 to CHAO et al. or US Patent #5,878,539 to GRUBB. As detailed in paragraph #2 above, DEMMER discloses the basic claimed skylight except for the ceiling mounted fixture being a material other than translucent. Both CHAO et al. and GRUBB teach that it is known in the art to form a ceiling mount (30) and (80); respectively, from a material other than translucent. In the case of CHAO et al., the ceiling mount (30) is lined with a reflective coating, column 3, lines 60-62, thereby making the ceiling

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mount not translucent. The ceiling mount (80) of GRUBB is made from aluminum, thereby, also not being translucent. It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the ceiling mount of DEMMER from a non-translucent material, as taught by either CHAO et al. or GRUBB, in order to have a skylight assembly that diffuses much of the light that may be imposed on the assembly. A translucent ceiling mount lets through much more light than an aluminum or reflectively lined ceiling mount. If less light is desired to pass through the assembly, a non-translucent material would have been obvious to use for one having ordinary skill in the art.

7. Claim 10 stands rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #5,502,935 to DEMMER. As disclosed in paragraph #2 above, DEMMER discloses the basic claimed skylight except for the skylight dome being white. Although DEMMER does not disclose the dome as being white, it would have been obvious to one having ordinary skill in the art at the time the invention was made to select a known material on the basis of its suitability for the use intended as an obvious matter of design choice. The selection of material depends heavily upon the desire or requirement of the material to transmit an optimum/minimum passage of light therethrough in order to effectively provide/diffuse light into a room. Again, a white light assembly diffuses the ability of light to pass through the assembly. If less light is desired, needed or required, a more colored or opaque dome would be used.

Response to Arguments

8. Applicant's arguments filed 7/29/02 have been fully considered but they are not persuasive.

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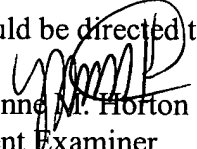
In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, and in regards to the applicant's argument that DEMMER does not show the use of a metalized plastic, DEMMER was not applied to teach the metalized plastic. AYLES is used to modify DEMMER to show a teaching for the use of metalized plastic, column 3, lines 42-48.

In regards to the applicant's argument of claim 5 in that DEMMER does not teach the use of a square tubing, DEMMER, column 8, lines 19-20, discloses that the tubing (20) can be circular or polygonal. A square is included as being a polygon.

In regards to the applicant's arguments to claims 9 and 10, the examiner has modified her rejections to better support her position.

In response to the applicant's argument of claims 6 and 8, these claims have been canceled and the arguments are rendered moot.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yvonne M. Horton whose telephone number is (703) 308-1909.


Yvonne M. Horton
Patent Examiner
Art Unit 3635
October 9, 2002